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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,804	04/21/2006	Donna Hui-Ing Hwang	GULDE-69	9868
23599 7590 06/11/2008 MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201				
EXAMINER				
SOROUSH, LAYLA				
ART UNIT		PAPER NUMBER		
1617				
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06/11/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/576,804

Applicant(s)

HWANG ET AL.

Examiner

LAYLA SOROUSH

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The response filed March 12, 2008 presents remarks and arguments submitted to the office action mailed December 12, 2007 is herein acknowledged.

The rejection of claims 1-6 and 8-13 under 35 U.S.C. 103(a) as being unpatentable over Lennon et al. (US 2003/0165451), supplied by the Applicant, in view of Rabe et al. (US 6,019,962) is maintained for the reasons of the record.

The rejection of claim 7 under 35 U.S.C. 103(a) as being unpatentable over Lennon et al. (US 2003/0165451) in view of Rabe et al. (US 6,019,962) and further in view of Suzuki et al. (US 5,219,560) is maintained for the reasons of the record.

The rejections are modified below to address the newly added limitations:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 12 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support for the limitation comprising "no emulsifying agent" as recited in claim 12.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term a starch "derivative," is rendered indefinite. One of ordinary skill in the art could not ascertain and interpret the metes and bounds of the patent protection desired as claimed in this case, since one of ordinary skill in the art would clearly recognize that many various groups could possibly be substituted in each instance. As a result, any significant variation would be reasonably expected to alter the compound, e.g. physical, chemical, physiological effects and functions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 8-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lennon et al. (US 2003/0165451), supplied by the Applicant, in view of Rabe et al. (US 6,019,962).

Lennon et al. teach cosmetic compositions for treating and protecting skin, nails, hair and/or mucous membranes against environmental conditions (e.g. cold, wind, heat,

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sunlight) and make-up compositions such as foundation, said compositions containing 0.1-50% by weight of a diblock, triblock or multiblock semicrystalline polymer soluble in the oily phase; 10-95% of a cosmetic oil (e.g. hydrocarbons, synthetic esters and ethers, fatty acids, fatty alcohols, etc.); 5-90% of water and 0.1-30% of other solvents; 0.1-20% of an organic powder such as microspheres formed from a terpolymer of vinylidene chloride, acrylonitrile and methacrylate having a particle size of 12-40 microns, or starch powders; and 0.01-50% of cosmetic additives, including thickeners. See pp. 2-9 and Composition Examples 5-8. The compositions of Lennon et al. contain as low as 0.1% of an emulsifier, which meets the limitation "eventually (sic, should read "essentially") no emulsifying agent" in Claim 12.

Lennon et al. does not teach the claimed water-repellent cross-linked polyester having a molecular weight of 600-8000, consisting of polyvalent alcohols and dicarbonic acids and no emulsifier.

However, Rabe et al. teach the claimed cross-linked polyesters (e.g. glycerine/diethylene glycol/adipate cross-polymers) useful in cosmetic compositions for improving transfer-resistance and long wearing properties of the compositions. See Abstract; col. 2, lines 45-55; col. 4, lines 55-60. Rabe et al. exemplify a composition containing 5% by weight of glycerine/diethylene glycol/adipate cross-polymer. See col. 10, Example 3. Rabe defines long wearing cosmetic products as "those that are resistant to blotting on to another object that comes in contact with the cosmetic product; for example, resistance to lip composition coming off onto table wear such as cups and napkins. However, other factors found to be critical in predicting long wear is

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the ability of the cosmetic product to be flexible and resistant to solvents such as food oils once applied to the skin." The teaching therefore, reads on the limitation resistant to solvents the simplest solvent being water.

It would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Lennon et al. such that to use cross-linked polyesters of Rabe et al. for their art-recognized purpose. One having ordinary skill in the art would have been motivated to do this to obtain improved transfer-resistance and long wear as suggested by Rabe et al. Additionally, the determination of optimal or workable concentration of emulsifying agent within the reference's broad disclosure by routine experimentation is obvious. One having ordinary skill in the art would have been motivated to do this to obtain the desired properties of the composition.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lennon et al. (US 2003/0165451) in view of Rabe et al. (US 6,019,962) and further in view of Suzuki et al. (US 5,219,560).

Lennon et al. in view of Rabe et al. applied as above. Neither reference teaches the cross-linked silicone polymers of the instant claim.

However, Suzuki et al. teach using such polymers in cosmetic compositions for providing water-repellency, water-resistance, oil-resistance and good retention of the makeup. See Abstract; col. 8-10, Examples.

Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to further modify the compositions of Lennon

et al. in view of Rabe et al. such that to use cross-linked silicone polymers of Suzuki et al. for their art-recognized purpose. One having ordinary skill in the art would have been motivated to do this to obtain improved water-repellency, water-resistance, oil-resistance and retention of the makeup as suggested by Suzuki et al.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Response to Arguments

Applicant's arguments filed March 12, 2008 have been fully considered. The response to the arguments is as discussed below:

Applicant's main arguments are Lennon does not teach a composition that is water resistant and contains essentially no emulsifying agent.

Applicant argues the limitation "water resistance" which was not previously presented in the claims. The limitation has been addressed in the rejection above. Additionally, Applicant argues the claim is drawn to a composition comprising essentially no emulsifying agent. The compositions of Lennon et al. contains as low as 0.1% of an emulsifier. Examiners position remains that 0.1% of an emulsifier meets the limitation "essentially" no emulsifying agent.

The arguments are not persuasive and the rejection is made **FINAL**.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAYLA SOROUGH whose telephone number is (571)272-5008. The examiner can normally be reached on 8:30a.m.-5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SREENI PADMANABHAN/
Supervisory Patent Examiner, Art Unit 1617